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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHANNES LAUTERBACH, BJOERN GOERKE,
MARKUS CHERDRON, and JENS ITTEL

Appeal 2009-008811
Application 10/676,364
Technology Center 2100

Before JOSEPH L. DIXON, ST. JOHN COURTENAY III, and
THU A. DANG, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-22 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We Affirm.

Invention

Appellants' invention relates generally to data processing by a computing device. More particularly, the invention on appeal is directed to developing applications. (Spec. 1).

Representative Claim

1. A computer program product, embodied in a tangible machine-readable storage device, for developing applications, the computer program product being operable to use a data processing apparatus to interact with data conforming to a data model, the data model comprising:
 - a component class;
 - a model class associated with the component class, the model class including a model-class class and a model relation class, the model-class class including a model class attribute class, and the model relation class including a model relation role class;
 - a controller class associated with the component class, the controller class including a context node class having a context attribute class, the context node class being associated with the model-class class and the model relation class, and the context attribute class being associated with the model class attribute class; and
 - a view class associated with the component class, the view class including a user interface element class having a binding with either the context node class or the context attribute class.

Prior Art Evidence

1. Template Software, SNAP Foundation Template: Using the SNAP Development Environment, pages 2-2 through 2-5, 3-6 through 3-40,

- 4-2 through 4-14, 6, 7, and 8-21, copyright 1998, released 1997 (hereinafter “SNAP”).
2. Template Software, Workflow Template (Process Template): Using the WFT Development Environment, chapter 3, copyright 1998, released 1997 (hereinafter “ENV”).
 3. Template Workflow Template Process Foundation, Developing a WFT System, entire Manual, copyright 1998, released 1997 (hereinafter “WFT”).

Rejection

Claims 1-22 stand rejected under 35 U.S.C. §102(b) as being anticipated by the combination of SNAP, ENV, and WFT.

Section 101 Rejection Withdrawn by Examiner

Although the Examiner’s final rejection includes a rejection under 35 U.S.C. § 101 (Fin. Rej. 2-3), the § 101 rejection is not repeated in the Examiner’s Answer. *See* Ans. 3, *et seq.* (omitting the § 101 rejection from the Grounds of Rejection section). Appellants’ Appeal Brief only addresses the rejection of claims 1-22 under § 102. (App. Br. 5, *et seq.*). *Accord* Ans. 2 (“The appellant’s statement of the grounds of rejection to be reviewed on appeal is correct.”).

In reviewing the prosecution history, we observe that in the Advisory Action mailed Dec. 21, 2007, the Examiner entered on appeal the after-final amendment filed Nov. 20, 2007, and the Examiner also indicates on pages 1 and 2 of the Advisory Action that the after-final amendment overcomes the § 101 rejection. Therefore, the §101 rejection for claims 1-15, as set forth in the final Office action mailed Aug. 23, 2007, is not before us on appeal.

To expedite review at the Board, we urge the Examiner to expressly indicate all withdrawn rejections in any future Answers. *Cf.* Manual of Patent Examining Procedure (MPEP) § 1207.02, 8th ed., Rev. 3, Aug. 2005 (“Grounds of rejection not specifically withdrawn by the examiner and not set forth in the examiner’s answer are usually treated by the Board as having been dropped . . .”).

Grouping of Claims

Appellants argue the anticipation rejection of claims 1-22 as a single group. (App. Br. 12, *et seq.*). We select independent claim 1 as the representative claim for the group. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUES

Based upon our review of the administrative record, we have determined that the following issues are dispositive in this appeal:

1. Have Appellants shown the Examiner erred in relying on multiple references as evidence to support the rejection of representative claim 1 under §102(b)?
2. Have Appellants shown the Examiner erred in finding that the SNAP reference discloses “a model class associated with the component class, the model class including a model-class class,” within the meaning of representative claim 1?

ANALYSIS

Issue 1

Appellants contend that the Examiner's use of multiple references in support of the rejection under § 102(b) is improper. (App. Br. 12).

Appellants note that the SNAP, ENV, and WFT references are not a single printed publication, as each reference has a different title and a different publication date. Appellants also contend that the Examiner has not complied with the guidance set forth in MPEP §2131.01. (*Id.*).

However, the Examiner disagrees that the reliance on multiple references in support of the rejection under § 102(b) is improper:

The references used in the rejection are manuals from The Template Software product line which contains:

The SNAP programming language

The WorkFlow Template

The Web Component

These three-layered products work together. Since, these products work together they constitute a single reference and can be used as the basis for a rejection based on anticipated by a product offering. Furthermore, with the 1997 press release announcing version 8.0 these [are] considered prior art under *In re Epstein* 31 USPQ2d 1817 (decided August 17, 1994) with a 1997 release date despite the 1998 copyright date. Being that this is a single product offering conditions A and C are met from MPEP 2131.01 in that the primary reference (SNAP) is a piece of the entire software suite provided by Template Software and being that the other manuals (ENV and WFT) detailing different pieces of the entire software suite which SNAP is a part of (product line) would be inherent.

(Ans. 11).

In the Reply Brief, the Appellants further illuminate the threshold issue in dispute:

However, *ENV* and *WFT* were not cited to prove that *SNAP* contains an enabled disclosure or to show that a characteristic not disclosed in *SNAP* is inherent. Before the Examiner's Answer, the Examiner never mentioned that that *ENV* and *WFT* are being cited to prove that *SNAP* contains an enabled disclosure or to show that a characteristic not disclosed in *SNAP* is inherent. For example, the Examiner failed to set forth in the Final Office Action how *ENV* and *WFT* prove that *SNAP* contains an enabled disclosure or how *ENV* and *WFT* show that a characteristic not disclosed in *SNAP* is inherent. In fact, the Final Office Action is completely silent with respect to any enablement issue or any inherency issue regarding *SNAP*. Contrary to the Examiner's newly-formed allegation that *ENV* and *WFT* were combined with *SNAP* for enablement and inherency purposes, *ENV* and *WFT* were cited in the Final Office Action as allegedly containing teachings of various elements of Appellant's claims. See, *e.g.*, Final Office Action, pp. 6, 9, and 10. Therefore, the Examiner's statement that combining *ENV* and *WFT* with *SNAP* meets conditions (A) and (C) of M.P.E.P. § 2131.01 is incorrect. Accordingly, the use of *SNAP*, *ENV*, and *WFT* in support of the rejection under § 102(b) is improper.

(Reply Br. 3).

At the outset, we find the Examiner's statement misplaced that "[s]ince, these products work together they constitute *a single reference*" (Ans. 11) (emphasis added). Because the Examiner has relied on three separate documents, they cannot be an invention that was patented or

described in “a printed publication” within the meaning of the plain language of 35 U.S.C. §102(b).¹ Thus, we agree with Appellants that the SNAP, ENV, and WFT references are not a *single* prior art *patent* or *printed publication* under § 102(b). (App. Br. 12).

Nor do we find support for the Examiner’s reasoning under MPEP § 2131.01. (Ans. 10-11). This section of the MPEP guides that a §102 rejection over multiple references has been held to be proper when the extrinsic references are cited to:

- (A) Prove the primary reference contains an “enabled disclosure;”
- (B) Explain the meaning of a term used in the primary reference; or
- (C) Show that a characteristic not disclosed in the reference is inherent.

¹ Cf. *Kyocera Wireless Corp. v. International Trade Com’n*, 545 F.3d 1340, 1351 (Fed Cir. 2008) (“The record evidence suggests that the GSM standard is not a single reference. The different specifications that comprise the GSM standard were authored by different subsets of authors at different times. Indeed, the GSM standard includes hundreds of individual specifications drafted by approximately ten different subgroups, each with its own title and separate page numbering. Each specification, though part of the greater GSM standard, stands as a separate document in its own right. Even Qualcomm’s witness—admittedly one of the most knowledgeable people in the world about the operation of GSM—testified that she had not read the entire standard and did not know of any person who had read the entire standard. Open Session Tr. 1712, Mar. 15, 2006. Under these circumstances, the GSM standard is actually several prior art references with separate dates of creation, rather than a single prior art reference.”).

(MPEP § 2131.01).

Based upon our review of the record, we agree with Appellants that “the Final Office Action is completely silent with respect to any enablement issue or any inherency issue regarding *SNAP*.” (Reply Br. 3). Moreover, the Examiner has not fully developed the record regarding the proper use of extrinsic references under the guiding provisions of MPEP § 2131.01 to establish inherency, enablement,² or the meaning of a term used in the *SNAP* reference that the Examiner refers to as “the primary reference.” (Ans. 11). Without more, we find unpersuasive the Examiner’s statement that “conditions A and C are met from MPEP [§]2131.01 in that the primary reference (*SNAP*) is a piece of the entire software suite provided by Template Software and being that the other manuals (*ENV* and *WFT*) detail[] different pieces of the entire software suite which *SNAP* is a part of (product line) would be inherent.” (Ans. 11).

However, this does not conclude our inquiry regarding anticipation under § 102(b).

Public Use or On Sale Anticipation under 35 U.S.C. §102(b)

In particular, we observe that the Examiner also states that “these products work together . . . and can be used as the basis for a rejection based

² See e.g., *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 1347-49 (Fed.Cir.2000) (a prior art reference that does not enable a person of ordinary skill in the art to practice the claimed invention does not anticipate the patent claims). *But cf. Symbol Techs. Inc. v. Opticon Inc.*, 935 F.2d 1569, 1578 (Fed. Cir. 1991)(“a non-enabling reference may qualify as prior art for the purpose of determining obviousness under [35 U.S.C.] § 103.”).

on [being] anticipated by a product offering. (Ans. 11; emphasis added). The Examiner also cites *In re Epstein*, 31 USPQ2d 1817 (Fed. Cir. 1994). (See Ans. 11). In *Epstein*, our reviewing court determined that the Board did not err in determining that various third-party software products were “in public use or on sale” more than one year before Applicant’s filing date based upon abstracts which indicated when the products were “first installed” or “released” more than one year prior to Applicant’s filing date.

Thus, on this record, the Examiner is also relying on an alternative ground to establish anticipation under 35 U.S.C. § 102(b) – *Public Use or On Sale Anticipation*. Under the pertinent portion of the statute, “A person shall be entitled to a patent unless . . . (b) the invention was patented or described in a printed publication in this or a foreign country *or in public use or on sale* in this country, more than one year prior to the date of the application for patent in the United States.” 35 U.S.C. § 102(b)(emphasis added).

In particular, we observe that the plain alternative language of § 102(b) (“*or in public use or on sale*”) is silent regarding any limitation on the number of references (or other forms of evidence) that may be used to establish *public use* or an *offer for sale* of a *single* anticipating invention, such as the public use or offer for sale of a particular *device* or *process*. Thus, multiple references (and other evidence) may be relied on under §102(b) to establish evidence of *public use* or an *offer for sale* of an anticipating invention.

For example, multiple references may be relied on to establish a date of *public use* or a date of an *offer for sale* and to also establish the various features of the single *anticipating device* that was “in public use or on sale in

this country, more than one year prior to the date of the application for patent in the United States.” 35 U.S.C. § 102(b).

Under this approach to establishing anticipation, the multiple references are *not separate anticipatory references*; rather, it is the single device that anticipates a claim if the multiple references (or other evidence) establish that the single device had all the claimed features and was in *public use* or was *offered for sale* “more than one year prior to the date of the application for patent in the United States.” (*Id.*).

Thus, “[a] party asserting that a patent claim is anticipated under 35 U.S.C. § 102 must demonstrate, among other things, identity of invention . . . [which] is a question of fact . . . one who seeks such a finding must show that each element of the claim in issue is found, either expressly described or under principles of inherency, in a single prior art reference, *or that the claimed invention was previously known or embodied in a single prior art device or practice.*” *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984) (citation omitted; emphasis added), *overruled on other gds.*, *SRI Intern'l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1125 (Fed. Cir. 1985). *See also Studiengesellschaft Kohle, rn.b.H. v. Dart Indus., Inc.*, 726 F.2d 724, 726-27 (Fed. Cir. 1984) (“anticipation must be found in *a single* reference, *device*, *or process.*”)(emphasis added).

Our reviewing court has provided further guidance regarding the “public use” and “on sale” doctrines under 35 U.S.C. § 102(b):

Whether something is “in public use or on sale” within the meaning of section 102(b), and thus properly considered prior art, is a question of law with

subsidiary issues of fact. *Manville Sales Corp. v. Paramount Sys., Inc.*, 917 F.2d 544, 549, 16 USPQ2d 1587, 1591 (Fed.Cir. 1990). The section 102(b) “public use” and “on sale” bars are not limited to sales or uses by the inventor or one under the inventor’s control, but may result from activities of a third party which anticipate the invention, or render it obvious. [(citations omitted)].

In re Epstein, 31 USPQ2d 1817, 1820 (Fed. Cir. 1994); *see also In re Omeprazole Patent Litigation*, 536 F.3d 1361, 1372 (Fed Cir. 2008) (“[I]t is clear from this court's case law that experimental use cannot negate a public use when it is shown that the invention was reduced to practice before the experimental use.”).

Here, we find Appellants have failed to address the Examiner’s alternative theory of public use anticipation under § 102(b). Both the principal Brief and the Reply Brief are silent regarding the Examiner’s use of the cited documents to establish evidence of public use anticipation. Arguments not made are considered waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Moreover, we observe that the overview of the “The Template Product Family” states that “[e]ach product in the Template family has been designed to seamlessly integrate and inter-operate with all of the others.” (p. 2). Therefore, on this record, we find Appellants have not shown³ that the

³ *See In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011) (“Jung argues that the Board gave improper deference to the examiner’s rejection by requiring Jung to ‘identif[y] a reversible error’ by the examiner, which improperly shifted the burden of proving patentability onto Jung. *Decision* at 11. This is a hollow argument, because, as discussed above, the examiner established

Examiner erred in relying on multiple references as evidence to support the rejection of representative claim 1 under §102(b) regarding *Issue 1*.

Issue 2

We consider next the issue of whether Appellants have shown the Examiner erred in finding that the SNAP reference discloses “a model class associated with the component class, the model class including a model-class class,” within the meaning of representative claim 1.

FINDINGS OF FACT (FF)

1. SNAP defines the “Display Class” as “[a]ny class that defines one of the display types that SNAP provides, for example, the BAR_CHART class.” (p. 4-4).
2. SNAP defines the “Domain class” as “[a] class that defines the domain; a class that describes the subject area of the application, for example, the class PLANE in the Cargo Monitor application. Typically, a domain class is a class that you have defined.” (p. 4-4).
3. SNAP defines the “Domain independent class” as “[a] class that defines the application, rather than the domain. For example, the predefined GUI classes are domain-independent classes. Most of the predefined classes are domain-independent. (p. 4-4).

a prima facie case of anticipation and the burden was properly shifted to Jung to rebut it. . . . ‘[R]eversible error’ means that the applicant must identify to the Board what the examiner did wrong”).

4. SNAP defines the “GUI class” as “[a]ny class that has the GUI class as an ancestor class. Thus, a domain class that inherits GUI or one of its subclasses is also a GUI class. For example, the BAR_CHART class is a GUI class, and the PLANE class in the Cargo Monitor application is a domain class and a GUI class. A GUI class can be predefined or it can be a class that you have defined. (p. 4-4).

Regarding *Issue 2*, Appellants present the following contentions regarding specific contested limitations recited in representative claim 1:

Nothing on pages 4-4 and 4-10 to 4-14 of *SNAP* can correspond to the claimed “model class,” “component class,” and “model-class class.” Moreover, even if classes in the cited portions of *SNAP* could correspond to the claimed “model class,” “component class,” and “model-class class,” which they cannot, *SNAP* fails to teach a “model class associated with the component class” and a “model class including a model-class class,” as required by claim 1 (emphases added). In other words, even if *SNAP* were to disclose the claimed classes, *SNAP* fails to teach or suggest the claimed relationships (e.g., “associated with” and “including”) between the claimed classes. Moreover, *ENV* and *WFT* also fail to teach the claimed classes and relationships between classes. Therefore, the cited references fail to teach or suggest all the elements of claim 1. For at least these reasons, the cited references fail to anticipate claim 1.

(App. Br. 14).

The Examiner disagrees:

The exact names of classes are not used by *SNAP* but *SNAP* does not claim relationships. From pages 4-4 through 4-10 it is explained that there exist a “Display classes”, “GUI class”, “Domain classes”, “Domain

independent classes” and more “GUI classes” associated with a GUI class. A Display class functions as a “component class”. A GUI Class functions as “model class”. A Domain class along with more GUI classes and Domain independent class function as “model-class classes”. The Display class is used as a starting point like a root node in a hierarchy, such that a Display class contains instructions to create and application in a window. Next a GUI class is used to decide which application will be placed in the window (e.g. bar chart). Then Domain class, Domain independent class, and further more GUI Classes (which make up small components to construct a desired application (e.g. scroll bar, title, etc) are used with the desired GUI Class (bar chart application) to create an application to be displayed in a window of the Display class. Therefore it is evident that SNAP shows a claim relationship which is identical to Appellants claimed language “model class associated with the component class” and a “model class including a model-class class.”

(Ans. 12).

At the outset, we observe that the disputed class names recited in representative claim 1 differ from the class names disclosed in the SNAP reference. (FF 1-4). However, anticipation “is not an ‘ipsissimis verbis’ test.” *In re Bond*, 910 F.2d 831, 832-33 (Fed. Cir. 1990) (citing *Akzo N.V. v. U. S. Int’l Trade Comm’n*, 808 F.2d 1471, 1479 n.11 (Fed. Cir. 1986)). “An anticipatory reference . . . need not duplicate word for word what is in the claims.” *Standard Havens Prods., Inc., v. Gencor Indus., Inc.*, 953 F.2d 1360, 1369 (Fed. Cir. 1991).

Here, the Examiner reads (Ans. 12) the claimed “component class” on the SNAP “Display Class” that is defined as “[a]ny class that defines one of the display types that SNAP provides, for example, the BAR_CHART

class.” (FF 1). The Examiner also reads (Ans. 12) the claimed “model class” (associated with the component class) on the SNAP “GUI class” that is defined as “[a]ny class that has the GUI class as an ancestor class.” Thus, a domain class that inherits GUI or one of its subclasses is also a GUI class. (FF 4).

We broadly but reasonably construe the claim term “associated with” as reading on *any* nexus between the claimed “model class” and the “component class”—even an attenuated nexus. (Claim 1). Because both the SNAP display class (i.e., component class) and the SNAP GUI class (i.e., model class) are depicted within the same TABLE 4-1 (SNAP, p. 4-4), and because both classes are associated with editors, we find that the SNAP display class (i.e., component class) and the SNAP GUI class (i.e., model class) are *associated with* each other, within the meaning of representative claim 1.

Appellants additionally contend that SNAP does not disclose a “‘model class including a model-class class,’ as required by claim 1.” (App. Br. 14). However, on this record, we find no substantive arguments⁴ (or evidence) presented by Appellants that specifically address the Examiner’s finding that “[a] Domain class along with more GUI classes and Domain independent class function as ‘model-class classes.’ The Display class is

⁴ Attorney arguments and conclusory statements that are unsupported by factual evidence are entitled to little probative value. *See In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997); *see also In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984); and *Ex parte Belinne*, No. 2009-004693, slip op. at 7-8 (BPAI Aug. 10, 2009) (informative), *available at* <http://www.uspto.gov/web/offices/dcom/bpai/its/fd09004693.pdf>.)

used as a starting point like a root node in a hierarchy, such that a Display class contains instructions to create an application in a window.” (Ans.12).

We also observe that SNAP discloses that a GUI class (i.e., model class) is any domain class that inherits GUI or one of its subclasses. (FF 4). We note that the SNAP “Domain class” is defined as “[a] class that defines the domain; a class that describes the subject area of the application.” (FF 2). The SNAP “Domain independent class” is defined as “[a] class that defines the application, rather than the domain.” (FF 3).

In particular, we observe that SNAP also discloses that “predefined GUI classes are domain-independent classes.” (FF 3). Therefore, a SNAP GUI class (i.e., model class) would include domain-independent classes (i.e., a model-class class). Accordingly, we find the weight of the evidence supports the Examiner’s position regarding the specific limitations contested by Appellants.⁵

For the aforementioned reasons, we find Appellants have not shown reversible error in the Examiner’s anticipation rejection of representative claim 1.⁶ Therefore, we sustain the Examiner’s anticipation rejection for representative claim 1 and claims 2-22 (not argued separately) which fall therewith. *See* 37 C.F.R. § 41.37(c)(1)(vii).

⁵ Arguments not made are waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

⁶ *See In re Jung*, 637 F.3d at 1365 (Fed. Cir. 2011).

DECISION

We affirm the Examiner's rejection of claims 1-22 under § 102(b).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

ORDER

AFFIRMED

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